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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,807	01/11/2002	Xuanchuan Yu	LEX-0298-USA	8020

7590 02/05/2003

Lance K. Ishimoto  
Lexicon Genetics Incorporated  
4000 Research Forest Drive  
The Woodlands, TX 77381

[REDACTED] EXAMINER

SWOPE, SHERIDAN

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 02/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/044,807	YU ET AL.	
	Examiner	Art Unit	
	Sheridan L. Swope	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 November 2002.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Applicant's response, in Paper No. 6, to the first Office Action on the Merits of this case is acknowledged. It is acknowledged that applicants have added new Claim 4. Claims 1-3 are hereby reconsidered; the newly added Claim 4 is considered.

### ***Claim Rejections - 35 USC § 101***

Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by a well established utility for either the nucleic acid molecule of SEQ ID NO: 1 or any nucleotide sequence encoding the amino acid sequence of SEQ ID NO: 2. Furthermore, the claimed invention is not supported by an asserted utility based on either a demonstrated function for the protein of SEQ ID NO: 2 or by a deduced function for said protein supported by homology to known proteins. The reasons for rejection are further described in the prior action.

Applicants argue that the present invention has a number of substantial and credible utilities. For example, applicant argue that the polymorphism at position 2467 of the polynucleotide set forth by SEQ ID NO: 1 could be used for forensic analysis. However, the presence of polymorphisms in human DNA is well established and virtually any locus on a human chromosome will exhibit one or more polymorphisms which could be so used. Applicants have not identified any particular reason for use of this particular polymorphism in forensic analysis or any particular benefit that would derive from analysis of this polymorphism. Applicants have also not identified any particular reason for use of this particular polynucleotide in "DNA chips" for the discovery of drugs associated with human disease and no specific human diseases have been shown to be due to or correlated with alterations in this particular polynucleotide. Likewise, applicants have not identified any particular reason for using this

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polynucleotide in mapping chromosome 9. As such all of the utilities asserted by applicants are not specific and substantial. Thus, the applicant's arguments are not found to be persuasive and, therefore, rejection of Claims 1-3 under 35 U.S.C. 101 is sustained. Since Claim 4 recites a host cell comprising the vector of Claim 3, Claim 4 is also rejected under 35 U.S.C. 101 for the reasons described in the prior action.

***Claim Rejections - 35 USC § 112***

Rejection of Claims 1-3 under 35 U.S.C. 112, first paragraph is also maintained for the reasons described in the prior action. Since Claim 4 recites a host cell comprising the vector of Claim 3, Claim 4 is also rejected under 35 U.S.C. 112, first paragraph for the reasons described in the prior action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 703-305-1696. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Sheridan L. Swope, Ph.D.

*Rebecca E. Prouty*  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
GROUP 1600  
1600